## **REMARKS**

Claim 53 is amended to correct an obvious error in formula I, i.e., the missing OH group; see, e.g., page 7, of the original disclosure. Claim 64 is amended to remove the inadvertent duplicate recitation of  $7\alpha$ -methyl-estra-1,3,5(10)-triene-3,16 $\alpha$ -diol and add the correct recitation of the corresponding 3,16 $\beta$ -diol compound; see, e.g., original claim 25. These rejections address the 35 U.S.C. §112, second paragraph, rejections. They do not narrow the scope of these claims but only correct obvious clerical errors. Further, the method claims 66-89 have been canceled and the right to file and prosecute these claims in a divisional application reserved. This should not be taken as an acquiescence in the rejections of these claims under 35 U.S.C. §112, first paragraph.

It is submitted that the above amendments would put the application in condition for allowance or materially reduce or simplify the issues for appeal. Obviously, the amendments render moot the rejections of the canceled method claims. The other rejections under 35 U.S.C. §112, second paragraph – i.e., the only other rejections – are also believed rendered moot. The amendments do not raise new issues or present new matter and do not present additional claims. The amendments were made to address the new 35 U.S.C. §112, second paragraph, rejections occasioned by clerical error in the claims and to remove the issue of the method claims. They were not earlier presented because the new errors just arose in the last amendment. Accordingly, it is submitted that the requested amendments should be entered.

It is submitted that the claims are in condition for allowance. However, the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

Appl. No.: 09/497,891 January 20, 2004

Reply to Final Office Action of November 4, 2003

**Page 24** 

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

John A. Sopp Reg. No. Attorney for Applicants No. 33,103

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.

Arlington Courthouse Plaza 1, Suite 1400

2200 Clarendon Boulevard

Arlington, Virginia 22201

Telephone: (703) 243-6333

Facsimile: (703) 243-6410

Attorney Docket No.: SCH-1692

Date: January 20, 2004

K:\Sch\1692\AF Reply to 11-4-03 OA.doc